REMARKS/ARGUMENTS:

The Applicant thanks the Examiner for the comments in the Office Action, which has been carefully considered. It is respectfully submitted that all issues raised are traversed, being hereinafter addressed with reference to the relevant headings appearing in the Detailed Action section of the Office Action.

Claim Rejections – 35 USC § 103

Claims 1-8 stand rejected under 35 USC 103(a) as being allegedly unpatentable over Koide *et al.* (US 6,870,566) in view of Nomura (US 5,625,770).

Applicant respectfully submits that the rejection is incorrectly raised. The cited references have been carefully reviewed and it is submitted that it is obvious the combination of cited references does not disclose or suggest the invention as claimed in either independent claim 1 or independent claim 8. The Examiner has failed to properly construe the present claims and relies on very generalised and essentially irrelevant disclosures in the cited references.

A claimed invention is not obvious in view of a proposed combination of references that fails to teach or suggest all of the claim recitations. Since nothing in the proposed combinations of references teaches or suggests the claim recitations, *prima facie* obviousness has not been established for these claims.

In order to carry the initial burden of establishing a *prima facie* case of obviousness that satisfies the *Graham* standard, the Examiner must at least show that the prior art reference must teach or suggest all the claim limitations, that there is some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference, and that there is a reasonable expectation of success for the proposed combination. *See* M.P.E.P. § 2143.

In the instant case, the Examiner has not established a *prima facie* case of obviousness because:

(1) neither Koide et al nor Nomura teaches or suggests each and every limitation of the claimed invention;

(2) there is no motivation to combine the teachings of Koide et al and Nomura; and

(3) there is no reasonable expectation of success for the proposed combination of Koide et al and Nomura.

Applicant respectfully submits that a *prima facie* case of obviousness has not been established to shift the burden of rebuttal to the Applicant. The Office Action of this case fails to identify any teachings or suggestions in the prior art that would have motivated one of skill to combine the cited supplemental reference with the primary reference. Further, the Office Action of this case fails to identify why the proposed combined prior art would have any reasonable expectation of success in producing the invention having characteristics recited in claim 1.

The Examiner relies on Koide et al as the primary reference which discloses general computer 12 being able to apply a desired effect to a stored image from FIFO memory 105 of an image sensing unit 11. The passage relied on by the Examiner in its entirety states:

"In the image sensing system, the control of the image sensing unit 11 is performed on the basis of the image sensing program loaded on the CPU 110 from the memory 114 by transferring instructions to the control unit 107 through the interfaces 111 and 109."

The Examiner has misread this passage. The passage actually talks of computer 12 controlling the image sensing unit 11, it does not discuss "applying desired effects to a stored image" from current claim 1. Image sensing unit 11 acquires images via lense unit 101. The whole point of the invention in Koide et al is to provide an image sensing apparatus/system capable of sensing an image at the highest possible rate that a computer can receive image data from without any loss of the date (col 6, lines 2-7).

Moreover, there is no suggestion in Koide et al to make use of a "feed mechanism for feeding a card having an array of dots past the optical reader" as required in present claim 1. There is absolutely no motivation in Koide et al as to why such a feature would provide any benefit or indeed how such a feature would be achieved. Feeding a card having an array of dots past the optical reader of Koide et al is non sensical as this could not effect the stated object of Koide et al to sense an image at the highest possible rate that a computer can receive the image data without any loss of the data.

The Examiner relies on the secondary reference Nomura to disclose most of the features of current claim 1. However, the Examiner's statements concerning the teaching of various features of claim 1 in Nomura are incorrect and should not be sustained. Firstly, Nomura relates to a file system in which file management is performed via a mark sheet instead of a keyboard (col 1, lines 10-11). Nomura is not in the same field of technology as Koide et al and there is no, and the Examiner has not identified and reason why there would be, motivation to combine the cited references or any reasonable expectation of success for the proposed combination of cited references.

Nomura necessarily requires use of catalogue cards and document cards. A catalogue card is placed on the top of a plurality of document cards when the cards are scanned by the image reader 1 (col 3, lines 16-18). A catalogue card is used for a catalogue of each document for items of card identification such as name, type of group and searching marks (col 3, lines 21-30). A card identification comprises a 2 x 3 matrix pattern and represents a file identification of the document.

There is absolutely no motivation to combine Koide et al and Nomura as Koide et al is not in any way concerned with file management of images obtained through image sensing unit 11. Furthermore, Koide et al has no suggestion of any mechanism or benefit thereof for using a catalogue card system for cataloguing or sorting document cards as this has no relevance to the object of the invention of Koide et al being to transfer image data to a computer without loss of data.

The Examiner relies on Nomura to teach, for example, "*an optical reader interface… to produce raw data from the bit pattern while the card is being fed past the optical reader, the raw data used to produce an image processing script*" as recited in present claim 1. The Examiner relies on CPU 3 of Fig. 1 of Nomura and col 2, lines 57-65. However, all that is disclosed in Fig. 1 and the cited passage of Nomura is that the CPU 3 detects the existence and position of a mark drawn on the catalogue card by means of detecting a run length of a black picture element and that the existence and position of the drawn mark is expressed as code data.

The existence and position of a drawn mark on a card cannot be construed to be "*an image processing script*" in the context of current claim 1. Referring to claim 1 of the present application, the image processing script is received by a processor to "apply the image processing script to the stored image to generate an output image with the desired effects".

There is no teaching or suggestion in Nomura that the code data can in any way function as an image processing <u>script</u> that can be applied to a stored image to generate an altered output image which has desired effects. There is no intention in the invention of Nomura, and indeed no teaching or suggestion, of producing an output image with desired effects from an original stored image. In Nomura, that relates only to a file management system, the code data is only used as cataloguing information for the plurality of document cards.

The Examiner has, respectfully, not established a *prima facie* case of obviousness. However, even if a *prima facie* case of obviousness is considered to exist, the Examiner has not established that each and every limitation of the invention as claimed in claim 1 or claim 8 is taught or suggested by Koide et al in view of Nomura for at least the a foregoing reasons.

Very respectfully,
Applicant/s:

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